

REMARKS

The Office Action of August 31, 2010, was received and carefully reviewed. Applicant thanks Examiner for her consideration in the Examiner Interview held on December 15, 2010 (“the Examiner Interview”). Claims 1-26 were pending in this application prior to the instant amendment. By this amendment, claim 1 is amended, and claims 27 and 28 are added. Support for the new claims can be found, for example, in paragraphs [0137]-[0141] of the instant application’s publication, U.S. Pat. App. No. 2006/0136327 A1 (“the ‘327 application”). No new matter has been added. Thus, claims 1-28 are currently pending for consideration.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-15 and 24-26 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that claims 1 and 24 are directed towards methods for assessing risk within an organization that are not sufficiently tied to an apparatus, such as a computer. Although Applicant does not necessarily agree with the Examiner in this regard, Applicant herein amends independent claim 1 to recite “assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments by a processor” (*emphasis added*). This amendment is supported by, for example, paragraphs [0047], [0075], [0243] and [0252] of the ‘327 application.

Applicant submits that the claimed processor both ties the steps of amended claim 1 to a machine and transforms the underlying subject matter to a different state or thing, in compliance with *In re Bilski*, 88 USPQ2d 1385 CAFC (2008). Claim 24 is also believed to be in compliance with § 101 because it incorporates all of the steps of claim 1, and claims 2-15, 25 and 26 are believed to be in compliance by virtue of their direct or indirect dependence on claim 1 or 24. Thus, Applicant respectfully requests withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 6, 8, 14, 16, 21 and 23-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0046128 to Heinrich (“Heinrich”), in view of U.S. Pat. App. Pub. No. 2003/0160818 to Tschiegg (“Tschiegg”). Claims 2-5, 7, 9-13, 15, 17, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heinrich and Tschiegg, and further in view of U.S. Pat. App. Pub. No. 2002/0138416 to Lovejoy et al. (“Lovejoy”). These rejections are traversed for the reasons advanced in detail below.

On pages 5 and 6 of the Office Action, the Examiner asserts that paragraph [0037] of Heinrich teaches the step of conducting an asset risk assessment independent of the zone of an associated asset, but admits that Heinrich fails to teach a zone risk assessment of the asset. Instead, the Examiner cites paragraphs [0058]-[0069] of Tschiegg as allegedly teaching the step of conducting a zone risk assessment assessing the risk level associated with placing an asset within a corresponding zone. *See, page 6 of the Office Action.*

Applicant initially submits that the Examiner has failed to establish a *prima facie* case of obviousness, as is required for a proper rejection under 35 U.S.C. § 103. According to *KSR International Co. v. Teleflex Inc.*, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. 550 U.S. 398 (2007). The analysis supporting a rejection under this section should be made explicit by the Examiner. *Id.* Further, “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner has failed to provide articulated reasons why it would have been obvious to combine the independent asset risk assessment allegedly of Heinrich, with the zone risk assessment of the asset allegedly of Tschiegg. Instead, the Examiner only generally asserts that “the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.” *See, page 7 of the Office Action.* Such an assertion is merely a conclusory statement insufficient to uphold a finding of obviousness, as made clear by *In re Kahn*.

Further, *KSR v. Teleflex* provides that it is important to “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” 550 U.S. 398. The Examiner provides no such reason why one skilled in the art would conduct risk assessments of an asset both independent and dependent of a zone, and not simply assess the risk of an asset under one such scenario, as is done by Heinrich and Tschiegg, for the sake of simplicity. Furthermore, the identification of such a reason would be impossible by the Examiner, because neither Heinrich nor Tschiegg discloses or suggests the

zones of the claimed invention; each asset being located in a zone; and the assessment of risk associated with placing an asset within that zone.

As discussed in the Examiner Interview, the zones of the claimed invention as environments built to contain assets. *See, paragraphs [0136]-[0141] of the '327 publication.* Assets can be registered to one or more zones, and a risk assessment of placing the asset in each of its associated zones can be conducted in addition to a risk assessment of the asset itself, independent of a zone. Zones may be, for example, a physical and environment zone, a network zone, a software engineering zone, and an MIS support zone. *See, paragraphs [0137]-[0141] of the '327 publication.* The Examiner relates the physical location disclosed in Tschiegg (e.g., the country, city, state and address shown in FIG. 2) to the claimed zone, and the filter function of paragraphs [0058]-[0069] of Tschiegg to the claimed step of conducting a zone risk assessment.

Applicants respectfully disagree with this characterization of Tschiegg. As even admitted by the Examiner on page 6 of the Office Action, paragraphs [0058]-[0069] of Tschiegg merely discloses a “filter function that allows for customized reporting about specific risk management segments” (*emphasis added*). Indeed, Tschiegg relates only to a database of risk management information and a graphical interface system for viewing stored risk management data. *See, paragraph [0003] of Tschiegg.* Thus, Tschiegg fails to disclose “conducting for each of said zones a respective zone risk assessment, comprising assessing the risk level associated with placing a respective asset within said respective corresponding zone”, as claimed. *Emphasis added.* Tschiegg fails to conduct any assessments or assess any risk levels and, consistent with its stated purpose, only regurgitates and displays previously stored data. Furthermore, such filtering described by paragraphs [0058]-[0069] of Tschiegg only manipulates the display of such stored data, and does not manipulate the data itself in any way that would be considered conducting a zone risk assessment or to assess the risk level associated with placing an asset within a zone. Tschiegg itself provides in paragraph [0058], “[f]ilters 40 manipulate data of risk management information 12 for display to users”; and in paragraph [0069], “[a] filter 40 may be used to filter data of graphic 50.¹²” *Emphasis added.*

Even if the Examiner were to continue to assert that the filtering function of Tschiegg is considered to be conducting a risk assessment, Tschiegg would still fail to conduct a zone risk assessment, comprising assessing the risk level associated with placing an asset within a zone.

Although the database of Tschiegg stores risk management information that may be associated with a location, it does not assess the actual risk of placing an asset within that location. For example, as shown in FIG. 2 and described in paragraphs [0069], “Asia and Australia” can be filtered, displaying a graphic interface of fire protection data with a scope of Asia and Australia. Although the interface may regurgitate stored fire protection data having some association with Asia and Australia, it fails to (a) actually conduct any such assessments, and moreover, (b) assess the fire protection risk level associated with placing a building within Asia and Australia. Instead, it simply provides the fire protection data to the user, whose risks can be attributed to any of number of causes including, for example, a lack of sprinklers in that building. *See, FIG. 2 of Tschiegg.* It cannot be said that Tschiegg actually assesses or even provides a risk level specifically associated with placing that building within Asia and Australia (*i.e.*, the “zones” alleged by the Examiner). The Examiner readily admits that Heinrich fails to teach a zone risk assessment, and Lovejoy, cited by the Examiner as allegedly disclosing maintaining registers, also fails to overcome these deficiencies.

Thus, none of Heinrich, Tschiegg and/or Lovejoy, taken alone or in combination, disclose, suggest or render obvious the invention as recited in claims 1, 16 and 24. Applicant submits, therefore, that the rejection of claims 1, 16 and 24 under 35 U.S.C. § 103 is improper, and should be withdrawn. The rejections of claims 2-15, 17-23, 25 and 26 are also believed to be improper at least for the reasons discussed above by virtue of their direct or indirect dependence on claims 1, 16 or 24. A rejection of similar grounds of claims 27 and 28 would also be improper by virtue of their dependence on claims 1 and 16, respectively.

In view of the foregoing, Applicant contends that the instant application is in condition for allowance, and respectfully requests notification of the same. If the Examiner believes a conference would be helpful in expediting prosecution of the instant application, he is invited to telephone the undersigned to arrange such a conference.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No.

19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

NIXON PEABODY, LLP

/Jeffrey L. Costellia, Reg.#35,483/

Jeffrey L. Costellia

Registration No. 35,483

NIXON PEABODY LLP
CUSTOMER NO.: 22204
401 9th Street, N.W., Suite 900
Washington, DC 20004
Tel: 202-585-8000
Fax: 202-585-8080